

Application No.: 09/924,494

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Docket No.: 325772026400

REMARKS

Claims 1-5, 22 and 23 are rejected under 35 USC 103(a) as being unpatentable over Machida (U.S. Patent 5,875,379) in view of Kasuya (U.S. Patent 5,571,653). This rejection is respectfully traversed

Applicants previously asserted that the Examiner failed to provide adequate evidence of a motivation to combine the cited references. In particular, in cols. 5 and 6, Machida discloses various components which comprise the preferred developer for use with the disclosed device. The Examiner admits that the claimed toner specifications are not disclosed in Machida. However, the Examiner asserts that Kasuya discloses the claimed toner. In response to Applicants' argument, the Examiner now asserts that the motivation to combine the references is that Kasuya discloses a toner that is made so that it is capable of developing electrostatic images, where the developing device of Machida is implemented to develop an electrostatic latent image by use of the toner. In other words, Kasuya discloses a toner, and since Machida needs to use a toner, the Examiner believes this is sufficient motivation to use the toner taught by Kasuya. However, the Examiner is neglecting to consider that Machida already discloses a developer but does not disclose the exact type of developer/toner claimed nor the type of developer/toner disclosed in Kasuya. One would have to have been motivated not only to use a toner (any toner) to make the device work, but one would have needed to have been motivated to switch from the toner already disclosed in Machida to the specific toner disclosed in Kasuya. According to the Examiner's logic, there would have been motivation to combine any reference which teaches any type of toner with the device of Machida. The fact is, there is no disclosure in Kasuya which would have motivated one of ordinary skill in the art to substitute the toner of Kasuya with the toner already disclosed by Machida. Merely because one reference teaches a type of toner and the other reference needs to use a type of toner is insufficient motivation to support this rejection.

Accordingly, the features of claims 1-5 and 22-23 are neither taught nor suggested by the cited art, either alone or in combination. Applicants respectfully request that this rejection be withdrawn.

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Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Machida in view of Kasuya as applied to claim 1 above, and further in view of Shimojo (U.S. 5,436,701). This rejection is respectfully traversed.

Claim 21 depends from claim 1. As stated above, Machida and Kasuya fail to teach or suggest the features of claim 1. Furthermore, Shimojo also fails to teach or suggest the features of claim 1. Therefore, Applicants respectfully request that this rejection be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

In the event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant(s) petition(s) for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or fees due in connection with this document to Deposit Account No. 03-1952 referencing docket no. 325772026400.

Dated: October 14, 2003

Respectfully submitted,

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